Remarks

35 U.S.C. § 102(b)

Claim 1 has been rejected under 35 U.S.C. § 102(b) as anticipated by Plant Breeder's Right (PBR) Application 20001727 (European Community) in view of sales of 'Rosy Glow' as early as July, 2000. Applicant respectfully disagrees and requests reconsideration.

Applicant traverses the appropriateness of any such rejection. Applicant is aware of the recently decided In re Elsner case, 381 F.3d 1125 (Fed. Cir. 2004), and is also aware that a request for reconsideration of In re Elsner has been made. Applicant disagrees with the holding in In re Elsner.

However, as summary for purpose of discussion only that In re Elsner applies, the Plant Breeder's Right Application 20001727 in combination with the foreign sales of 'Rosy Glow' did not enable the 'Rosy Glow' trees even under the In re Elsner test. The Federal Circuit in In re Elsner held that although foreign sales in combination with an otherwise non-enabling publication may be a bar to patentability, a determination must be made to determine whether those skilled in the art would be aware of the foreign sales, and if so, whether those sales enabled those skilled in the art to reproduce the plant without undue experimentation. 381 F.3d 1125, 1131 (Fed. Cir. 2004). As discussed in the enclosed Declaration signed by Tony Willcocks, 'Rosy Glow' trees distributed prior to May 31, 2001, the critical date, were only distributed to a few orchardists (fruit growers) in Australia. Furthermore, each recipient was under an agreement not to propagate or distribute the trees. Therefore, those sales did not enable those skilled in the art to reproduce 'Rosy Glow' trees without undue experimentation, because those in possession of the trees were not permitted to propagate or distribute 'Rosy Glow' trees.

In the present application, the PTO concludes that possession alone is capable of enabling the PBR publication in combination with the foreign sales which resulted in possession of the 'Rosy Glow' trees by one skilled in the art. In re Elsner states that this conclusion is not correct. Id. at 1128. As held in In re LeGrice, the test to determine if a publication such as a PBR publication is a bar under 35 U.S.C. § 102(b) is "whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention of which a patent is sought." 301 F.2d 929, 939 (CCPA 1962). As discussed above, all of the Australian orchardists in possession of 'Rosy Glow' trees prior to May 31, 2001, were under a contractual agreement which expressly forbade these orchardists from propagating or distributing the

'Rosy Glow' trees. Therefore, even though PBR Application 20001727 describes the 'Rosy Glow' variety, this publication is not a bar under 35 U.S.C. § 102(b) under In re Elsner because those skilled in the art were not permitted to obtain 'Rosy Glow' trees for the purpose of propagating or distributing the trees.

Any rejection of the present application should therefore be withdrawn under 35 U.S.C. § 102(b).

Objections to the Disclosure

Applicant has amended the specification to include the information requested by the examiner.

A. A further comparison of 'Rosy Glow' to 'Cripps Pink' now appears on page 2.

B. Page 4, line 11 has been amended to correct the spelling of "bark".

C. Page 5, line 4 has been amended to clarify that the leaf texture is glabrous.

D. Information on the length and diameter of the flower bud now appears on page 7.

E. Page 7, line 25 has been amended to clarify the color information.

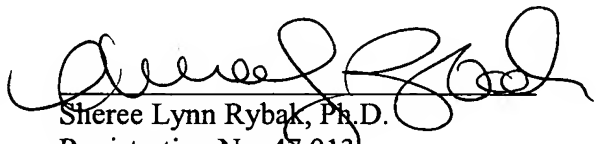
In view of these amendments, Applicants request that the 35 U.S.C. § 112 rejections be withdrawn.

The application should be allowed.

If there are any issues that need to be resolved before a Notice of Allowance is issued, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By 
Sheree Lynn Rybak, Ph.D.
Registration No. 47,913

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 228-9446